

nevertheless been amended to expedite the prosecution of the application. Applicants accordingly request the withdrawal of the rejection.

Claims 29-48 are rejected as being obvious over Hagemeister et al. taken together with either one of Ellenbogen et al. or Long. Applicants have reviewed the grounds for the rejection, but traverse for the reasons set forth below.

According to the Examiner, Hagemeister et al. disclose preparing a milk product from cows having an increased amount of omega-3 highly unsaturated fatty acid. The Examiner then acknowledges Hagemeister et al. fail to disclose the particular type of omega-3 or the use of the same in feed. To supplement the failure of Hagemeister et al, the Examiner contends that such use in feed is well known as taught by either one of Ellenbogen et al. or Long. The Examiner then concludes that absent a showing of unexpected results, it would have been obvious to feed the cows the omega-3 as an alternative source for producing the products described in Hagemeister et al.

It is well-recognized that a *prima facie* case of obviousness must be established by the Examiner before the burden shifts to the Applicant to show otherwise. Obviousness, however, cannot be established from a combination of references without some teaching, suggestion or motivation to combine them coupled with a reasonable expectation of success. In re Dow Chemical Co., 5 U.S.P.Q. 1529, 1531 (Fed. Cir. 1988); Carella v. Starlight Archery, 804 F.2d 135, 231 U.S.P.Q. 644, 647 (Fed. Cir. 1986). In addition, such suggestion or motivation to combine must come from the prior art references themselves and not from hindsight analysis using Applicant's specification to provide the suggestion or motivation. In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

First, it appears to Applicant that Ellenbogen et al., Comp. Biochem. Physiol., 29:805-811 (1969), which was disclosed in Applicant's Information Disclosure Statement, does not mention the use of omega-3 acids or any polyunsaturated fatty acids in the feed of cows or other animals. Applicant therefore requests the Examiner to specify the passage in this reference that

teaches the use of such feed. If the Examiner is citing a different Ellenbogen et al. reference, Applicant requests a complete citation and copy of the reference.

In any event, Applicant contends neither Hagemeister et al. nor Long provide the necessary motivation or suggestion to combine the cited references. Applicant notes Hagemeister et al. infused menhaden oil into lactating cows. Unlike Hagemeister, Long describes the oral ingestion of lipids containing omega-3 acids as nutritional supplements in food for humans and other animals without teaching the effect of these supplements on the omega-3 fatty acid content of milk produced by such animals. Far from providing the motivation to combine, Applicant submits that Hagemeister et al., in fact, teach away from the oral ingestion of omega-3 fatty acids as described by Long to produce milk enriched with omega-3 fatty acids. According to Hagemeister et al., there “has been controversy over whether and, if so, how much of the long-chain polyunsaturated omega-3 fatty acids in marine oils can be utilized by the bovine mammary gland for milk fat synthesis, even if they are protected from biohydrogenation by rumen microflora.” Thus, it is clear from this passage that Hagemeister et al. were concerned about the potential adverse effects of the rumen microflora and chose to “protect” the omega-3 fatty acid by infusing the marine oil rather than feeding the oil to avoid exposure to the cows’ rumen.

In clear contrast to Hagemeister, Applicant’s claims are directed to feeding an animal a feed containing an effective amount of omega-3 highly unsaturated fatty acid to increase its content in the milk produced by the animal. Applicant accordingly contends that a *prima facie* case of obviousness has not been established since neither Hagemeister et al. nor Long provide the necessary teaching, suggestion or motivation to combine them.

Since the initial burden has not been satisfied, the burden of showing unexpected results does not shift to Applicant. Although the burden is not properly shifted, Applicant nevertheless submits that Hagemeister et al., in fact, provide the evidence showing the results of the claimed

invention was unexpected since they attempted to avoid rumen microflora (i.e., “protect” the omega-3 fatty acids) by infusing marine oil rather than adding it to feed.

Since the cited references fail to provide the motivation to combine, Applicant contends the motivation apparently comes from his own teachings. However, it is well-recognized that such “hindsight analysis” using the teachings in Applicant’s specification to provide “the ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious” is improper. In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992) Applicant accordingly submits that under the guidance provided by the Federal Circuit, a *prima facie* case of obviousness has not been established in this case.

The Examiner further alleges that certain claim limitations found in the dependent claims, such as specific strains of organism, particular growth media, the moisture content of the feed and the preparation of feed by extrusion, are all “well within the purview of a skilled artisan” or “well within the purview of one having ordinary skill in the art.” In this regard, Applicant notes the Federal Circuit has long recognized that assertions made in support of an obviousness rejection require evidence either from the prior art or knowledge generally available to one of ordinary skill in the art. See, In re Fine, 5 U.S.P.Q.2d 1596, 1998-99 (Fed. Cir. 1988). In the Fine case, the Federal Circuit reversed the PTO’s obviousness rejection based, in part, on the examiner’s failure to offer any support for the assertion that “substitution of one type of detector of another in the system of [the prior art] would have been within the skill of the art.” Id.; see, also, In re Grabiak, 226 U.S.P.Q. 870, 872 (Fed. Cir. 1985) (since the PTO cited no pertinent reference showing or suggesting the claimed modification to one of ordinary skill in the art, the Court held that a *prima facie* case of obviousness had not been established).

Similar to the Fine and Grabiak cases, no supporting evidence from the prior art or knowledge generally available to one of ordinary skill in the art, such as an affidavit under 37 C.F.R. 10.107(b), has been provided to support the conclusory statements used to reject the

claims in the present case. Accordingly, Applicant contends a *prima facie* case of obviousness has not been established with respect to these claims.

Based on the foregoing, Applicant requests the withdrawal of the rejections of claims 29-48 and solicits an allowance of the pending claims. The Examiner is invited to contact the undersigned should any issues remain.

Respectfully submitted,

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